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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/815,735 | 04/02/2004 | Carl Diez | 4510-0117PUS1 | 1543 |

2292 7590 04/27/2005

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| EXAMINER |
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DUNWOODY, AARON M

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| ART UNIT | PAPER NUMBER |
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3679

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,735

Applicant(s)

DIEZ, CARL

Examiner

Aaron M Dunwoody

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 1-19 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/11/2005.

Applicant's election with traverse of the non-elected invention in the reply filed on 3/11/2005 is acknowledged. The traversal is on the ground(s) that claim 1 is generic because the subject matter is included in independent claims 8 and 20. This is not found persuasive because claim 1 is a sub-combination of independent claims 8 and 20. The invention of claim 1 is a staple; the invention of claim 8 is an inside cap with a staple; and the invention of claim 20 is a coupling with a staple.

Further, page 1 of the disclosure of the instant application states, "The present invention relates to an inside coupling and cap for corrugated conduits". Page 5 recites:

Referring to Figure 1, the non-restrictive illustration embodiment of the coupling according to the present invention is an inside coupling 11 to be inserted within mutually facing open ends of the corrugated conduits.

Therefore, the Examiner must conclude that the claims drawn to the elected invention are claims 20-31, and claim 1 is not generic.

The requirement is still deemed proper and is therefore made FINAL.

Priority

No priority claimed.

Information Disclosure Statement

No Information Disclosure Statement submitted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-23, 25-27 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication US 2004/0208728 A1, Fattori et al.

In regards to claim 20, Fattori et al disclose a coupling (10) comprising:

a tubular member (20) having two opposite open ends, defining a geometrical longitudinal axis, having an outer surface, having a first section, a second section, wherein each of the first and second sections comprises at least one staple (26, 30) comprising a mechanically compliant convex wall slanted toward the open end of the other of first and second sections, and the mechanically compliant convex wall comprises:

an elongated wall base connected to the outer surface of the tubular member;

a sloping convex surface; and

a free edge.

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Note, the corrugated conduits are not part of the claimed invention, and not considered by the Examiner.

In regards to claim 21, Fattori et al disclose the elongated wall base being a curved base.

In regards to claim 22, Fattori et al disclose the free edge of the mechanically compliant convex wall being a curved edge.

In regards to claim 23, Fattori et al disclose the free edge of the mechanically compliant convex wall lying in a plane substantially perpendicular to the geometrical longitudinal axis of the tubular member.

In regards to claim 25, Fattori et al disclose each of the first and second sections of the tubular member comprising a plurality of staples distributed on the outer surface of the tubular member along a circle centered on the geometrical longitudinal axis.

In regards to claim 26, Fattori et al disclose the tubular member further comprising at least one stopper (28) on the outer surface of the tubular member between the first and second sections of the tubular member, the open end of the each of the first and second corrugated conduits having a free edge abutting against the at least one stopper upon inserting the corresponding tubular member in the corrugated conduit through the open end of the corrugated conduit to limit the course of the tubular member within the corrugated conduit.

In regards to claim 27, Fattori et al disclose the axial distance between the at least one stopper and the at least one staple of each of the first and second sections being so selected that the at least one staple is located in one of the valleys of the inner

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surface of the corrugated conduit when the free edge of the open end of the corrugated conduit abuts against the at least one stopper.

In regards to claim 31, Fattori et al disclose each of the first and second sections comprising, at the corresponding open end, a bevelled rim.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-23 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 4711472, Schnell.

In regards to claim 20, Schnell discloses a coupling (60) comprising:

a tubular member having two opposite open ends, defining a geometrical longitudinal axis, having an outer surface, having a first section, a second section, wherein each of the first and second sections comprises at least one staple (68) comprising a mechanically compliant convex wall slanted toward the open end of the other of first and second sections, and the mechanically compliant convex wall comprises:

an elongated wall base connected to the outer surface of the tubular member;
a sloping convex surface; and
a free edge.

Note, the corrugated conduits are not part of the claimed invention, and not considered by the Examiner.

In regards to claim 21, Schnell discloses the elongated wall base being a curved base.

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In regards to claim 22, Schnell discloses the free edge of the mechanically compliant convex wall being a curved edge.

In regards to claim 23, Schnell discloses the free edge of the mechanically compliant convex wall lying in a plane substantially perpendicular to the geometrical longitudinal axis of the tubular member.

In regards to claim 25, Schnell discloses each of the first and second sections of the tubular member comprising a plurality of staples distributed on the outer surface of the tubular member along a circle centered on the geometrical longitudinal axis.

In regards to claim 26, Schnell discloses the tubular member further comprising at least one stopper (66) on the outer surface of the tubular member between the first and second sections of the tubular member, the open end of the each of the first and second corrugated conduits having a free edge abutting against the at least one stopper upon inserting the corresponding tubular member in the corrugated conduit through the open end of the corrugated conduit to limit the course of the tubular member within the corrugated conduit.

In regards to claim 27, Schnell discloses the axial distance between the at least one stopper and the at least one staple of each of the first and second sections being so selected that the at least one staple is located in one of the valleys of the inner surface of the corrugated conduit when the free edge of the open end of the corrugated conduit abuts against the at least one stopper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fattori et al.

In regards to claim 28, Fattori et al disclose the claimed invention except for the at least one stopper comprising a plurality of tabs projecting radially from the outer surface of the tubular member and distributed along a circle centered one the geometrical longitudinal axis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the at least one stopper with a plurality of tabs projecting radially from the outer surface of the tubular member and distributed along a circle centered one the geometrical longitudinal axis, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

In regards to claim 29, Fattori et al disclose each of the first and second sections further comprises a plurality of axial ribs of guidance (92) circumferentially distributed on the outer surface of the tubular member, the ribs of guidance sliding on the inner surface of the corrugated conduit upon-inserting the corresponding section of the tubular member in the corrugated conduit through the open end of the corrugated conduit.

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In regards to claim 30, Fattori et al disclose the ribs of guidance comprising at the corresponding open end of the tubular member ends that are bevelled to facilitate insertion of the tubular member in the corrugated conduit through the open end of the corrugated conduit.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because it illustrates the inventive concept of the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aaron M Dunwoody
Primary Examiner
Art Unit 3679

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